

REMARKS

In the most recent office action, claims 1-16 were pending. Claims 5-6, 8, 11-14, and 16 are withdrawn from consideration. Claims 1-4, 7, 9-10 and 15 are rejected.

In response, claims 1-4, 7, 9-10 and 15 are amended. No new matter is added.

Election/Restriction

Applicant acknowledges the election requirement being made final in the present case.

Specification

The Office Action states that the abstract of the disclosure is objected to for undue length. In response, Applicant has amended the abstract to comply with patent office practice. Entry is respectfully requested.

The Office Action also states that the terminology used in the specification is not necessarily the same as that generally accepted in the art to which the invention pertains. Applicant has amended the specification and claims to clarify the terminology. Entry of these changes is respectfully requested. No new matter is added.

AMENDMENT TO THE DRAWINGS

Fig 3 is amended to show a reference plane A-A. Entry is respectfully requested.

Fig. 4 is amended to show the extrusion piece with a cylindrical portion as described in the specification. Entry is respectfully requested.

Drawings

Applicant submits new formal drawings with this response for consideration by the Examiner. A reference line is added to Fig. 3. The external shape of the piece in Fig. 4 is corrected to conform with the description in the specification. No new matter is added. Entry is respectfully requested.

Claim Rejections - 35 U.S.C. §112

The Office Action states that claims 1-4, 7, 9, and 15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. The rejection is respectfully traversed.

Claims 1-4, 7, 9, and 15 have been amended to clarify their content and more distinctly claim the subject matter of the present invention. For example, claims 1 and 4 recite a tool electrode attached to a tip of a rotation shaft, rather than a rotation axis. In addition, the product of the invention is described as an aluminum extrusion hollow shape to for the clarify the subject matter of the invention. Claims 9 and 15 are amended to recite a pressure tube in a hollow portion of the tool electrode. Support for this recitation is found on page 12, line

20-page 13, line 12. It should be noted that the pressure tube is composed of plastic in an exemplary embodiment.

Applicant respectfully believes that the above amendments further clarify the invention recited in claims 1, 4, 7, 9-10, and 15, so that one of ordinary skill in the art would easily understand the scope of the subject matter claimed with a reasonable degree of certainty. Applicant therefore respectfully requests that the rejection of claims 1, 4, 7, 9-10 and 15 under 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

Claim Rejections - 35 U.S.C. §103

The Office Action states that claims 1-4, 7 and 10 are rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Applicant's admitted prior art (AAPA). In particular, the Office Action states that Applicant's disclosure recites all the elements, or obvious variations thereof in the background of the specification. The rejection is respectfully traversed.

Referring to the background section of the specification, Applicant notes that the relevant portions (page 4, lines 12-16) cited in the Office Action do not refer to a specific type of material. However, the discussion on page 4 of the background section of the specification indicates the differences between

processing internal cylindrical regions of items composed of different materials. For example, the difficulty in processing aluminum is discussed in comparison with steel, and processes that may be suitable for use with steel or stainless steel tubes are not suitable for aluminum extrusion hollow shapes.

Claims 1, 4, 7, 9-10 and 15 have been amended to specify that the apparatus and product of the present invention is related to an aluminum extrusion hollow shape. Accordingly, AAPA does not anticipate or make obvious the apparatus or product of the present invention, because AAPA fails to disclose a number of elements that are recited in the claims. Accordingly, Applicant respectfully requests that the rejection of claims 1-4, 7, 9-10 and 15 under 35 U.S.C. §102(b) or, in the alternative, 35 U.S.C. §103(a), be reconsidered and withdrawn.

Conclusion

Claim 17 is added to the application as including subject matter that Applicant has a right to claim. Entry and reconsideration on the merits is respectfully requested.

Applicant respectfully believes that all issues raised in the most recent Office Action are addressed in the present response. In view of the above amendments and discussion, Applicant

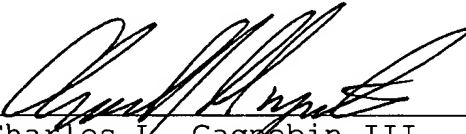
Application No. 09/341,339
Filed: August 30, 1999
TC Art Unit: 3723
Confirmation No.: 5010

respectfully submits that the present application is now in condition for allowance, and earnestly solicits to that effect.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

TADASHI AIURA ET AL.

By: 
Charles L. Gagnebin III
Registration No. 25,467
Attorney for Applicant(s)

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEOVICI LLP
Ten Post Office Square
Boston, MA 02109
Telephone: (617) 542-2290
Telecopier: (617) 451-0313

CLG/ad
316096